

Remarks

The non-final Office Action dated May 8, 2009, lists the following rejections: claims 1-8 and 12-19 stand rejected under 35 U.S.C. § 103(a) over Erixon (U.S. Patent No. 7,233,678); claims 9-11 and 20 stand rejected under 35 U.S.C. § 103(a) over the ‘678 reference in view of Clark (U.S. Patent No. 6,134,336); claim 5 stands rejected under 35 U.S.C. § 112(2); and claim 1 is rejected on the ground of nonstatutory obviousness-type double-patenting over claim 1 of U.S. Patent No. 6,628,790. In this discussion set forth below, Applicant does not acquiesce to any rejection or averment in this Office Action unless Applicant expressly indicates otherwise.

Applicant respectfully traverses the § 103(a) rejections because the cited Erixon ‘678 reference either alone or in combination with the Clark ‘336 reference lacks correspondence to the claimed invention. For example, neither of the asserted references teaches the claimed invention “as a whole” (§ 103(a)) including aspects regarding, *e.g.*, a sound-delivery chamber to amplify the sound conveyed into the acoustic free space relative to the sound conveyed into the space bounded by the ear. Because neither reference teaches these aspects, no reasonable interpretation of the asserted prior art, taken alone or in combination, can provide correspondence to the claimed invention. As such, the § 103(a) rejections fail.

More specifically, the Examiner acknowledges that the ‘678 reference does not teach a sound-delivery chamber as in the claimed invention. For the deficiencies of the ‘678 reference, the Examiner improperly relies upon Official Notice in attempting to assert that such a sound-delivery chamber is well-known without providing the documentary evidence required to support such a conclusion, and without identifying any reference and alleged motivation as would be proper for Applicant to consider and respond to the rejection. Consistent with M.P.E.P. § 2144.03, Applicant respectfully requests evidence in support of the proposition that such teaching is well known in the prior art and that there is adequate evidence of motivation to combine this prior art with the main reference. Applicant notes that the Examiner makes multiple additional conclusions based upon Official Notice in an attempt to address various dependent claims, none of which are supported by documentary evidence as required.

Moreover, the Examiner has improperly proposed modifying the ‘678 reference in a manner that was already anticipated by Applicant and the impropriety of which was explained in detail by Applicant in the previous response. *See, e.g.*, M.P.E.P. 707.07(f). Specifically, the ‘678 reference teaches away from modifying sound channel 22 into a chamber that amplifies the sound generated by speaker 16. Consistent with the recent Supreme Court decision, M.P.E.P. § 2143.01 explains the long-standing principle that a § 103 rejection cannot be maintained when the asserted modification undermines either the operation or the purpose of the main (‘678) reference - the rationale being that the prior art teaches away from such a modification. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007) (“[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious.”). In this instance, the ‘678 reference is directed to decreasing the size of the device and, in particular, to decreasing its thickness. *See, e.g.*, Col. 3:7-25. As such, the ‘678 reference teaches away from modifying sound channel 22 in a manner that would increase the size of the device, as proposed by the Examiner. The impropriety of the Examiner’s proposed modification of the ‘678 reference is further highlighted by the rejections of various dependent claims in which the Examiner improperly attempts to modify the ‘678 reference to include additional chambers (*e.g.*, a sound-deflection chamber as in claim 10, and another sound-delivery chamber as in claims 16-20). Such modifications would substantially increase the size and thickness of the device taught by the ‘678 reference and, as such, the ‘678 reference teaches away from these modifications.

In view of the above, the § 103(a) rejections are improper and Applicant requests that they be withdrawn.

Applicant respectfully traverses the § 112(2) rejection of claim 5 because the Examiner’s continued insistence that antecedent basis is required for a claim term (*i.e.*, a portion of the sound-delivery chamber) that is being introduced for the first time is improper and contrary to the requirements of § 112(2). Applicant notes that claim 5 (and its parent claim 10) do not exclude the sound-delivery chamber from having a portion that opens to the first housing region. In contrast, claim 1 recites that the sound-delivery chamber conveys sound from the loudspeaker through the first housing region, thereby

suggesting that a portion of the sound-delivery chamber opens to the first housing region. Notwithstanding, to facilitate prosecution, Applicant has amended claim 5 to recite that the sound-delivery chamber has a portion that opens to the first housing region. Applicant submits that this amendment is not being made for purposes of patentability, but solely to facilitate prosecution, and that this amendment is not intended to change the scope of claim 5. Thus, Applicant requests that the § 112(2) rejection of claim 5 be withdrawn.

Applicant respectfully traverses the obviousness-type double-patenting rejection of claim 1 over claim 1 of U.S. Patent No. 6,628,790. Specifically, claim 1 of the '790 patent does not include a sound-delivery chamber to amplify the sound conveyed into the acoustic free space as in the claimed invention. The Examiner improperly relies upon Official Notice in attempting to assert that such a sound-delivery chamber is well-known without providing the documentary evidence required to support such a conclusion. *See, e.g.*, M.P.E.P. § 2144.03 discussed above. Thus, the obviousness-type double-patenting rejection fails for the same reasons discussed above in relation to the Examiner's improper use of Official Notice in connection with the § 103(a) rejections. Accordingly, the obviousness-type double-patenting rejection of claim 1 is improper and Applicant requests that it be withdrawn.

In view of the above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilska, of NXP Corporation at (408) 474-9063 (or the undersigned).

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